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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,072	04/08/2004	Shinichi Hasegawa	09812.0524-00000	2104
22852 7590 03/25/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER TO, TUAN C	
			ART UNIT 3663	PAPER NUMBER
			MAIL DATE 03/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/822,072	Applicant(s) HASEGAWA ET AL.	
	Examiner TUAN C. TO	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/4/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/20/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 12, 14, and 16 are rejected under 35 U.S.C. 102 (e) as being anticipated by Carroll et al. (US 20030097211A1).

As to claims 1 and 14, Carroll et al. teaches an on-board apparatus mounted on a vehicle comprising: a getting means for getting vehicle model information by determining a connector that is used to connect to an on-board signal outlet, such as OBD-II to receive diagnostic code. In figure 3a, the user interface provides a list of vehicle' country (vehicle model information) for user to select. Carroll et al. teaches the computer system (200) for recognizing vehicle model based on the input signal from the user interface (Carroll et al., figure 2, page 3, paragraph 0037). Carroll et al. further teaches a function setting means which is the button (32) (Carroll et al. figure 3b) and another button shown in figure 3c. All of said buttons are utilized to set the design information related to function or operation of the vehicle (Carroll et al., figure 3d, including a list of design data-manufacturer, year, model has been set). Carroll et al.

further teaches a display device for displaying function design of the vehicle set by said buttons (Carroll et al., figure 2, display 212).

In paragraph 0027, the remote service provider (150) maintains a user database (154) and a service database (152) which stores various types of data such as service data for various automotive services and vehicle models (paragraph 0027, lines 10 and 11), software applications, specifications, parameter, user's manual, and other data related to vehicle diagnoses. In paragraph 0036, Carroll et al. teaches that a user can submit a request to access a web page from the remote service provider (150). The web pages contain user information for the user to retrieve data stored in service database (152) into user database (154). At this point, it is clear that the database (154) stores the vehicle model information downloaded from the service database (152). In addition, the user interface disclosed shown in figure 3b including a layout of screen, thus the storage device (21) as seen in figure 2 comprises information necessary for layout screen as seen in figures 3b-3d.

It is noted that while teaching a getting means for getting vehicle model information Carroll et al. inherently discloses that the getting means determines a shape of a connector. In Carroll et al., a connector is used to connect the OBD-II to the vehicle (see paragraph 0025). Each OBD-II inherently determines the shape of a connector when the connector is fixed into the OBD-II.

As to claims 12, and 16, the layout screen in figures 3b and 3c includes selection box for user setting a specific data to model, year of the a vehicle, and therefore in order

to that happen, the storage devices shown in figure 2 should store function setting information.

Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll et al. (US 20030097211A1) and in view of Kataghishi (US 20040210363A1).

Carrol et al. teaches an on-board apparatus mounted on a vehicle comprising: a getting means for getting vehicle model information. For example, in figure 3a, the user interface provides a list of vehicle' country (vehicle model information) for user to select.

Carrol et al. teaches the computer system (200) for recognizing vehicle model based on the input signal from the user interface (Carrol et al., figure 2, page 3, paragraph 0037).

Carrol et al. further teaches a function setting means which is button (32) (Carrol et al. figure 3b) and another button shown in figure 3c. All of said buttons are utilized to set the design information related to function or operation of the vehicle (Carrol et al., figure 3d, including a list of design data-manufacturer, year, model has been set). Carrol et al. further teaches a display device for displaying function design of the vehicle set by said buttons (Carrol et al., figure 2, display 212). Carrol et al. fails to teach storage means for storing the vehicle model information and related design information of function information.

The reference to Kataghishi et al. provided to cure the missing features from Carrol et al. by teaching an on-board apparatus to be mounted on a vehicle (Katagishi et al, figure 1, onboard apparatus 3), wherein said on-board apparatus (3) comprises a

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storage device (34) that stores vehicle model information such as manufacturer ID, car ID, etc. (Katagishi et al., page 3, paragraph 0032, line 7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the onboard apparatus as taught by Carroll et al. to include the storage device that stores vehicle model information as taught by Katagishi et al. in order to retrieve download information related to a vehicle from a list of vehicle that have previously had vehicle repair services.

Claims 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll et al. (US 20030097211A1) and in view of Borgesson (US 20050203684A1).

Carroll et al. fails to include “function setting information comprises at least one of a navigation function, a mileage measuring function, and a night-vision function”.

Borgesson teaches a vehicle control system and method including “function setting information comprises at least one of a navigation function, a mileage measuring function, and a night-vision function” (see paragraph 0080).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the teachings of Borgesson into the system of Carroll et al. so that the operator user can keep track on the mileage history of a selected vehicle via a screen.

Response to Applicant's Arguments

The applicant's arguments and amendment filed on 01/23/2008 have been fully considered, however, they are not persuasive.

The applicant argued in his response, regarding the rejection of claims 1 and 14, by stating that Carroll does not disclose: "getting vehicle model information from the vehicle by determining a shape of a connector used to attach the onboard apparatus to the vehicle", "a formed position of a connector".

It is important to note that Carroll et al. teaches an on-board apparatus mounted on a vehicle. An OBD-II is used as an on-board apparatus mounted on a motor vehicle for diagnosing the vehicle on-board system that do not limit to engine, brake, suspension, etc. In order to receive diagnostic code from a vehicle, the OBD-II is connected to a connector exited on-board of a motor vehicle model for performing a kind of diagnosing. Thus, said OBD-II inherently includes a determination of a "shape" or "formed position" of such the connector when the connection is completed.

For that reason, at least claims 1 and 14 are rejected as being anticipated by Carroll et al.

Claims 13 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll et al. (US 20030097211A1) and in view of Borgesson (US 20050203684A1). As discussed herein above, Carroll et al. identically discloses the limitations of claims 12, and 14. Carroll et al. merely fails to include "function setting information comprises at least one of a navigation function, a mileage measuring function, and a night-vision function". The reference to Borgesson teaches a vehicle

control system and method including “function setting information comprises at least one of a navigation function, a mileage measuring function, and a night-vision function” (see paragraph 0080). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the teachings of Borgesson into the system of Carroll et al. so that the operator user can keep track on the mileage history of a selected vehicle via a screen.

For that reason, claims 1, 2, and 12-17 are unpatentable over the cited prior art.

Conclusions

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan C To/

Acting Examiner of Art Unit 3663/3600

March 6, 2008

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